

REMARKS

A. BACKGROUND

The present Amendment is in response to the Office Action mailed February 17, 2010. Claims 3-7 and 28-35 were pending and rejected in view of cited art. Claims 3 and 29 are amended.¹ Claims 3-7 and 28-35 remain pending in view of the above amendments, with claims 3 and 29 being independent.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, are consistent with the Examiner's understanding.

B. PRIOR ART REJECTIONS

I. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejected claims 3-7 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,059,201 (*Asnis*) in view of U.S. Patent No. 6,090,063 (*Makower*). Claims 29-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Asnis* in view of *Makower* and U.S. Patent No. 5,462,562 (*Elkus*). Applicant respectfully traverses.

Asnis was cited as disclosing "a shaft 24 having a proximal end and a distal end and an axis therebetween, the shaft having a groove (lumen) formed in a side thereof, the groove extending from the distal end toward the proximal end and being in communication with an opening formed in the side (proximal tip) of the shaft" (Office Action, p. 2). The Office Action does not identify the "opening" in any more detail and, as such, the location of the "opening" of

¹ Any amendments to the claims other than those which are expressly relied upon in overcoming the rejections on art have been made simply to insure consistency of claim language, to correct typographical or grammatical errors, or to correct other errors of a formal, non-substantive nature, but not to otherwise narrow the claims in scope for any reason.

Asnis is not clear to Applicant. From the disclosure of *Asnis* it appears that the only "opening" in the shaft close to the distal end is the distal end of the lumen of shaft 24. In the event that, *arguendo*, the "opening" is such lumen distal end, Applicant respectfully submits that *Asnis* neither teaches nor suggests the invention claimed in independent claims 3 and 29 as amended and presented herein. In particular, to clarify the location of the "opening," independent claim 3 as amended and presented herein recites, as exemplary, "the shaft having a lumen extending from the proximal end toward the distal end, the shaft having a groove and an opening formed in a side thereof in close proximity to the distal end of the shaft, the groove extending from the distal end toward the proximal end and communicating with the lumen distal the opening" (emphasis added).² No mention is made in *Asnis* of a groove and opening being formed in a side of the shaft and that both communicate with a lumen. At most, *Asnis* discloses, *arguendo*, the inclusion of a lumen in the shaft with a distal end. Since the distal end of the lumen of *Asnis* is unable to be both the "groove" and the "opening" of independent claim 3, Applicant respectfully submits that *Asnis* neither teaches nor suggests the invention of independent claim 3 or independent claim 29, which includes similar limitations.

Accordingly, for at least the reasons noted, independent claims 3 and 29 and the claims depending therefrom³ are neither anticipated nor made obvious by *Asnis*, either singly or in combination with the other cited prior art of record⁴, and thus reconsideration and withdrawal of the rejection under Section 103 is respectfully requested.

² Independent claim 29 is similar to independent claims 3. Claim 29 differs from claim 3 in that it recites, in part, "a shaft having a proximal end and a distal end and an axis therebetween, a bore extends from the distal end toward the proximal end, the shaft having a groove and an opening formed in and through a wall of the shaft in close proximity to the distal end of the shaft, the groove extending from the distal end toward the proximal end and being in communication with the bore distal the opening, the groove also being in communication with the opening formed in the side and wall of the shaft, the opening communicating with the bore, being disposed proximal the distal end of the shaft and the groove" (emphasis added). Claim 29 should be allowed for the same reasons as claim 3.

³ Emphasis herein of the differences between the independent claims and the prior art are equally applicable to the dependent claims 4-7, 28, and 30-35, but this does not mean, on the other hand, that these are necessarily the only differences between the claimed invention and the prior art of record. Applicant thus does not acquiesce in any asserted rejections of dependent claims 4-7, 28, and 30-35.

⁴ *Makower* and *Elkus* were cited as secondary references. *Makower* was cited for the proposition that it discloses "a proximal edge on the opening of the shaft that moves toward a distal edge of an opening", while *Elkus* was cited for the proposition that it discloses "a suture passer with a fitting 13 fixed within a bore of a shaft 10" (Office Action, pp. 4 and 6). That said, none of these references otherwise add anything in terms of reading on the claims as amended herein, particularly in reference to those claimed limitations noted able which clearly define over *Asnis*. Thus, even assuming *arguendo* that any of the references to *Makower* and *Elkus* are properly combinable with *Asnis*, such combinations are clearly distinguishable by the claims for the reasons already noted in reference to *Asnis*.

C. CONCLUSION

In view of the foregoing, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as provide the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are neither anticipated by nor made obvious by the art of record. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 17th day of May, 2010.

Respectfully submitted,

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